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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,745	11/13/2003	Barrie P. Swain	7851	8904
22922	7590	08/11/2004	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA GABRIEL, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			SWIATEK, ROBERT P	
			ART UNIT	PAPER NUMBER
			3643	
DATE MAILED: 08/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/712,745

Applicant(s)

SWAIN, BARRIE P.

Examiner

Robert P. Swiatek

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-37 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-10, 13-15, 17, 18, 20-23, 38 and 39 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 11, 12, 16, 19, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-20-04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicant should note that due to the absence of claims numbered 31, 32, claims 33-41 have been renumbered as claims 31-39, respectively. Dependencies have been changed to reflect the renumbering.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 8, 13-15, 17, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Dersch (US 564,976: Ref. B on Information Disclosure Statement by Applicant). The Dersch saddletree includes an elongated spring element in the form of two overlying plies A, B and a curved strip C of rigid material secured by rivets to ply A. Although only two plies A, B are shown, page 1, lines 35-41, of Dersch notes the saddletree can be composed of more than two plies, with the plies increasing in length from the bottom of the saddletree (when in use) to the top. While the spring element performs tapered in thickness from its center portion to its ends because of the differing lengths of the plies, lines 38-40 of Dersch state each individual ply also is reduced in thickness near its ends; together, the tapering and reduction in thickness permit progressive flexibility and resilience in response to flexure of the end portions so they “automatically adjust themselves to the back of any horse” (page 1, lines 47, 48, of Dersch). As to claims 2, 17, if the Dersch saddletree is turned upside down, the plies increase in length from

top to bottom. With respect to claims 15, 23, the rivet-like elements d of Dersch securing strip C to ply A are considered to be pins.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 9, 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dersch in view of Nankivell (US 3,712,024). While the Dersch plies are constructed from leather, use of nylon or thermoplastic in their construction would have been obvious to one skilled in the art, in view of the teaching of Nankivell (see column 3, lines 11-15, of Nankivell) that such material eliminates the inherent weaknesses of traditional materials and enables production of a smoothly contoured, completely reproducible saddletree.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dersch. Use of metal in the construction of the Dersch plies, while not disclosed, nonetheless would have been obvious to one skilled in the art wishing to increase their durability and strength.

Claims 38, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Dersch. If the Dersch saddletree is turned upside down, the plies overlap one another from smallest-length ply to longest-length ply. Dersch additionally notes in column one of the patent that more than two plies can be joined together, one atop the next.

Claims 2-4, 7-16, 26-31, 39 are objected to because of the following informalities: In claim 2, line 13, "overlay" should be changed to "overlie"; in claim 7, line 16, "exhibit" should

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be changed to –exhibits–; in claim 26, line 24, “exhibit” should be changed to –exhibits–; in claim 39, line 7, “overly” should be changed to –overlie–, in line 10, “segment” should be changed to –segments–, in line 11, “portion” should be changed to –portions–, in line 12, “overlying” should be changed to –overlying–. Appropriate correction is required.

Claims 4, 6, 11, 12, 16, 19, 24, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The disclosure is objected to because of the following informalities: On page 20, lines 14, 20, “overlying” should be changed to –overlying–.

Appropriate correction is required.

The abstract of the disclosure is objected to because in line 14, “horse’s” should be changed to –horses–. Correction is required. See MPEP § 608.01(b).

The patents to Padgitt (US 542,940) and Walker et al. (US 3,286,440) have been cited to provide additional examples of saddle constructions.

RPS: ©703/308-2700  
5 August 2004

*Robert P. Swiatek*

ROBERT P. SWIATEK  
PRIMARY EXAMINER  
ART UNIT ~~323~~ 3643